



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/066,255	04/24/1998	KENNETH F. BUECHLER	234/116	8585

7590

04/24/2002

RICHARD J. WARBURG, ESQ.
FOLEY & LARDNER
402 W. BROADWAY
23RD FLOOR
SAN DIEGO, CA 92101

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Notification of Non-Compliance with
37 CFR 1.192(c)**

Application No.
09/066,255

Applicant(s)
Buechler et al

Examiner
Maurie E. Garcia, Ph. D.

Art Unit
1627



– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

The Appeal Brief filed on Oct 15, 2001 is defective for failure to comply with one or more provisions of 37 CFR 1.192(c). See MPEP § 1206.

To avoid dismissal of the appeal, applicant must file IN TRIPLICATE a complete new brief in compliance with 37 CFR 1.192(c) within the longest of any of the following three TIME PERIODS: (1) ONE MONTH or THIRTY DAYS from the mailing date of this Notification, whichever is longer; (2) TWO MONTHS from the date of the notice of appeal; or (3) within the period for reply to the action from which this appeal was taken. EXTENSIONS OF THESE TIME PERIODS MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 1.192(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, pending or cancelled, or does not identify the appealed claims (37 CFR 1.192(c)(3)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 1.192(c)(4)).
4. ☐ The brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing, if any, by reference characters (37 CFR 1.192(c)(5)).
5. ☒ The brief does not contain a concise statement of the issues presented for review (37 CFR 1.192(c)(6)).
6. ☐ A single ground of rejection has been applied to two or more claims in this application, and
 - (a) ☐ the brief omits the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet presents arguments in support thereof in the argument section of the brief.
 - (b) ☐ the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief.
7. ☒ The brief does not present an argument under a separate heading for each issue on appeal (37 CFR 1.192(c)(8)).
8. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 1.192(c)(9)).
9. ☒ Other (including any explanation in support of the above items):

Please see attached.

**NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37
CFR 1.192(c)**

1. The brief does not contain arguments of the appellant with respect to each of the issues presented for review in 37 CFR 1.192(c)(6), and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on as required by 37 CFR 1.192(c)(8).

2. The brief does not contain, for each rejection under 35 U.S.C. 103, an argument which specifies the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection, and an explanation how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument must explain why the references, taken as a whole do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not be properly combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of 37 CFR 1.192(c)(8)(iv).

3. There are two rejections under 35 U.S.C. 103 that were made final in the last Office Action (Paper No. 12).

(1) From paragraph 10 of the final Office Action: "Claims 30 and 34 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Margaron et al (J. Photochem. Photobiol. B 1992-on PTO-1449, Paper No. 8) in view of Renzoni et al (US 5,135,717) further in view of Freytag (US 4,434,236)."

and

(2) From paragraph 11 of the final Office Action: "Claims 28 and 32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Margaron et al (J. Photochem. Photobiol. B 1992-on PTO-1449, Paper No. 8) in view of Renzoni et al (US 5,135,717) and further in view of Freytag (US 4,434,236) as applied to claims 30 and 34 above, and further in view of Stanton et al (US 4,803,170)."

4. Appellant has not addressed either of the above rejections, instead referring to Margaron et al in view of Renzoni et al *only*. This is explained in more detail below.

5. Appellant does not list the separate rejections in the "Issues" section (Brief, page 8; also see below), "The Examiner's Rationale" section (Brief, page 9) or the "Argument" section (Brief, page 15). Instead, appellant states that the "Examiner contends that the claims are allegedly unpatentable over Margeron *et al.*, *J. Photochem. Photobiol. B* 14: 187-99 (1992), in view of Renzoni *et al.*, U.S. Patent No. 5, 135, 717" (Brief, page 9) and that "the instant claims are not obvious of over [sic] Margeron *et al.*, *J. Photochem. Photobiol. B* 14: 187-99 (1992), in view of Renzoni *et al.*, U.S. Patent No. 5, 135, 717 (Brief, page 15). As set forth above, the

rejection to which appellant is referring is **not** one of the rejections currently pending in the instant case.


6. Moreover, although the Brief does contain a section entitled "Issues"; this section does not comply with MPEP 1206 (6), cited below (emphasis added):

(6) Issues. A concise statement of the issues presented for review. ***Each stated issue should correspond to a separate ground of rejection*** which appellant wishes the Board of Patent Appeals and Interferences to review. While the statement of the issues must be concise, it should not be so concise as to omit the basis of each issue. For example, the statement of an issue as "Whether claims 1 and 2 are unpatentable" would not comply with 37 CFR 1.192(c)(6). Rather, the basis of the alleged unpatentability would have to be stated, e.g., "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones," or "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure." ***The statement would be limited to the issues presented, and should not include any argument concerning the merits of those issues.***

Appellant's "Issues" section of the brief contains a considerable number of arguments. Also, as above, each of the rejections under 35 U.S.C. 103 is not separately addressed in this section. In fact, no reference to the specific 103 rejections (i.e. claims under rejection with which set of references) is made whatsoever.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 8:30 to 6:00.

8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


DR. JYOTHSNA VENKAT PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Maurie E. Garcia, Ph.D.
April 20, 2002